

PATENT APPLN. NO. 10/532,085
RESPONSE UNDER 37 C.F.R. §1.111

PATENT
NON-FINAL

REMARKS

The specification has been amended to correct minor errors noted therein. The amendments are supported by the context of the paragraphs in which they are made and the specification as a whole and do not raise new matter issues.

Claims 1, 11 and 12 have been amended to define the proportion of the precipitated calcium carbonate particles deposited on the cellulose or lignocellulose fibrils of the filler used in the method of the present invention as being between 70 - 85 % of the weight of the filler and being that which does not cause the air permeability of the envelope paper or paper or board product to change by more than 10% when the amount of the filler is increased from 10 % by weight to 30 % by weight, on the basis of the weight of a precipitated calcium carbonate component of the filler and the weight of the web.

Claim 7 has been canceled.

The limitations relating to the proportion of the calcium carbonate particles deposited on the cellulose or lignocellulose fibrils of the filler used in the method of the present invention are supported in the specification of the present application on page 7, lines 13-16, and page 3, lines 27-31.

The rejections in the Action are discussed below using the headings used in the Action.

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Claim Rejections - 35 USC § 102 and USC § 103

The Office has maintained the 35 U.S.C. § 102 and, alternative, 35 U.S.C. § 103(a) rejections of the claims of the application over each of Silenius et al., WO 02/92909, and Silenius et al., US 2004/0173329, that were made in the previous Action. Prior to responding to these rejections, applicants note that WO 02/92909 and US 2004/0173329 are corresponding patent application publications. Therefore, the publications will be referred to collectively as "Silenius" in the following comments and the comments apply to both sets of rejection.

The claims as amended overcome the 35 U.S.C. § 102 and 35 U.S.C. § 103(a) rejections. The claims require that proportion of the deposited precipitated calcium carbonate particles of the filler used in the method of the present invention be between 70 - 85 % of the weight of the filler and be that which does not cause the air permeability of the paper or board product to change by more than 10% when the amount of the filler is increased from 10 % by weight to 30 % by weight, on the basis of the weight of a precipitated calcium carbonate component of the filler and the weight of the web. Both conditions must be satisfied.

Silenius is insufficient to support anticipation of the claims of the application under 35 U.S.C. § 102 because, first, the only specific content of calcium carbonate of the filler disclosed in

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Silenius is 69.7 %. (Paragraph [0048] of Silenius (US 2004/0173329). Second, Silenius discloses nothing concerning the proportion of the deposited precipitated calcium carbonate particles of the filler being such that the air permeability of the paper or board product changes at a maximum of 10% when the amount of the filler is increased from 10 % by weight to 30 % by weight, on the basis of the weight of a precipitated calcium carbonate component of the filler and the weight of the web. In Example 2 of Silenius, the air permeability resistance changes from 26.5 to 32.3, i.e., 21.9 %, when the amount of filler is increased within the range of 10 % by weight to 30 % by weight, i.e., from 17.8 % to 22.4 %.

Moreover, the fact that the use in the method of the present invention of a filler in which the proportion of the deposited precipitated calcium carbonate particles is between 70 ~ 85 % of the weight of the filler can provide an envelope paper or board product having an air permeability which does not change by more than 10% when the amount of the filler is increased from 10 % by weight to 30 % by weight, on the basis of the weight of a precipitated calcium carbonate component of the filler and the weight of the web, is an unexpected result sufficient to rebut any prima facie obviousness under 35 U.S.C. § 103(a) asserted by the Office to be supported by Silenius.

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Removal of the 35 U.S.C. § 102 and 35 U.S.C. § 103(a) rejections is in order and is respectfully requested.

Double Patenting

Claims 1-3 and 7-8 of the application are provisionally rejected on the ground of nonstatutory obviousness type double patenting (ODP) as being unpatentable over claims 12 and 16 of copending Application No. 10/475,773; claims 1 and 3-7 of copending Application No. 10/532,481; claims 16-22 and 24 of copending Application No. 11/808,273; and claims 1 and 6-9 of copending Application No. 11/992,595.

Applicants respectfully request that the ODP rejections be held in abeyance pending the determination of allowable subject matter in the present and copending applications.

The foregoing is believed to be a complete and proper response to the Office Action dated January 12, 2010, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

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In the event any additional fees are required, please also
charge our Deposit Account No. 111833.

Respectfully submitted,

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